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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Warehouse Fashion Limited

Serial No. 76048329

H. John Campaign and John W. McGlynn of Graham Campaign P.C.
for Warehouse Fashion Limited.

Dezmona J. Mizelle, Trademark Examining Attorney, Law
Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Hanak, Bucher and Bottorff, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Warehouse Fashion Limited, a British company, seeks
registration on the Principal Register of the mark
WAREHOUSE for services recited in the application, as
amended, as follows:

Retail store services and mail order catalog
services in the field of clothing, footwear
and headgear, bags, rucksacks, backpacks,
jewelry, imitation jewelry, perfumes,
cosmetics and toilet articles and
chronometric and horological instruments,
via the Internet.¹

¹ Application Serial No. 76048329 was filed by A.G. Clothing Limited on May 15, 2000 based upon applicant's allegation of first use in 1976 and use in commerce at least as early as 1984.

The application, as amended, seeks registration under Section 2(f) of the Trademark Act (15 U.S.C. §1052(f)) as a result of the mark acquiring distinctiveness due to substantially exclusive and continuous use of the mark in commerce for at least five years preceding the filing date of this application.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon the ground that this term is generic, and hence violative of Section 2(e)(1) of the Act. In the alternative, the Trademark Examining Attorney has taken the position that even if the mark is not found to be generic, the claim of acquired distinctiveness does not overcome the highly descriptive nature of the matter.

Thus, the issues on this appeal are whether the term WAREHOUSE is generic for applicant's services and, if not, whether applicant's claim of distinctiveness is sufficient to establish that such term, although merely descriptive of

The application was assigned to Warehouse Fashion Limited as of October 23, 2001 (USPTO Assignment records, Reel 2466, Frame 0252). Immediately prior to this appeal, the application was divided, and the six classes of goods were placed in a "child" application that has been prosecuted separately [Serial No. 76976261, which in turn matured into Reg. No. 2853340].

retail store services and mail order catalog services, has acquired distinctiveness.

When the refusals were made final, applicant appealed. Applicant and the Examining Attorney submitted briefs. Applicant did not request an oral hearing.

We affirm the refusals to register.

It has been repeatedly stated that "determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" H. Marvin Ginn v. International Association of Fire Chiefs, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Of course, in a proceeding such as this, the genus of services at issue are the services set forth in the recital of services in the application itself. Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) ["Thus, a proper genericness inquiry focuses on the description of services set forth in [the application or] certificate of registration."].

Moreover, the burden rests with the Trademark Examining Attorney to establish that the mark sought to be

registered is generic for the services as recited in the application. In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1997). It is incumbent upon the Trademark Examining Attorney to make a "*substantial showing* ... that the matter is in fact generic." Indeed, this substantial showing "must be based on *clear evidence* of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, it is beyond dispute that "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Furthermore, any doubt whatsoever on the issue of genericness must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

Addressing the first part of the Ginn genericness inquiry above, we agree with applicant that the genus of services at issue in this case is retail store services and mail order catalog services.²

² It is not clear if or how the final words in this recital, namely the phrase "via the Internet," might affect the genus of services herein. Based on the entire record herein, we assume the retail store services involve a "bricks and mortar" operation, and that the Internet may well be used in connection with the mail order services. In any case, this has not been discussed in the context of this prosecution.

We turn next to the second part of the Ginn genericness inquiry: whether the matter applicant seeks to register, WAREHOUSE, is understood by the relevant public primarily to refer to the genus of services at issue, i.e., retail store services.

In support of her position that this term is generic for the recited services, the Trademark Examining Attorney included LEXIS/NEXIS articles and Internet information. The following five NEXIS articles were the only ones included from among 156 "hits" found when searching for the combined term "warehouse retailing":

HEADLINE: ***Mike Farrah, Home Depot tool guy almost bleeds orange***

By the time [Mike Farrah] landed at University of Southern California, he was hooked on retailing. Farrah's studies focused on entrepreneurship and ***warehouse retailing***. What better textbook to work from than his father's?

The Atlanta Journal and Constitution,
October 20, 2002.

HEADLINE: ***Boston Capital, Wholesale Disaster***

Warehouse retailing is a business with three competitors. Besides BJ's [Wholesale Club Inc. based in the Boston metro area], the publicly traded Costco Wholesale Corp. and the Sam's Clubs operated by Wal-Mart Stores Inc. cover the country and some foreign markets.

The Boston Globe, October 6, 2002.

HEADLINE: ***Last of Downtown Duluth, Minn. Grocers
to Close in January***

In an era of 24-hour **warehouse retailing**, the Ideal Market and Bakery is a bit of Americana: A melting pot of a grocery store where downtown professionals looking for ethnic specialties and street people looking for basic staples get in line behind the same cash register.

Duluth News Tribune, November 26, 1998.

HEADLINE: ***Stock price rise raises eyebrows***

[Robert J. McNulty] founded the company that became HomeBase Inc. of Irvine, considered a pioneer of the **warehouse retailing** concept. The former champion sailor was out of town Friday and unavailable for comment.

Orange County Register, March 14, 1998.

HEADLINE: ***The Power Retailers: Toys 'R' Us Looks
for '97 Revival***

... [Roger] Goddu, largely credited with helping Toys 'R' Us move from **warehouse retailing** to full merchandise presentation, left TRU in December 1996 to assume the presidency of Montgomery Ward. ...

Discount Store News, February 3, 1997.

The following quotation appeared on the Internet as part of the syllabus for a Graduate School of Management course from Medaille College. The course is entitled "Marketing Through New Media" (MBA 604). The extensive quotation on the Internet, of which the following is only a small portion, appears to have been republished online from a Prentice-Hall textbook, Principles of Marketing:

What is Retailing?

...

🔴 Product line: retailers can also be classified by the *depth* and *breadth* of their product assortments:

...

Superstores, combination stores, and hypermarkets are all larger than the conventional supermarket. ... Hypermarkets combine discount, supermarket, and **warehouse retailing**, and operate like a warehouse -- products in wire baskets are stacked high on metal racks, and forklifts move through aisles during selling hours to restock shelves ...

...

🔴 Relative prices: retailers can also be classified by the prices they charge. Most retailers charge regular prices and offer normal quality goods and customer service. Some offer higher quality goods and service at higher prices. Retailers that feature low prices include:

Discount stores sell standard merchandise at lower prices by accepting lower margins and selling higher volume. Occasional discounts or specials does [sic] *not* make a store a discount store. A true discount store *regularly* sells its merchandise at lower prices, offering mostly national brands, not inferior goods.

In recent years, facing intense competition from other discounters and department stores, many discount retailers have "traded up" by improving their decor, adding new lines and services, and opening suburban branches. This, of course, has led to higher costs and prices. With the discounters trading up, off-price retailers have moved in to fill the low-price, high-volume gap. They obtain a changing and unstable collection of higher-quality merchandise, often leftover goods, overruns, and irregulars at reduced prices from manufacturers or other retailers. The three main types of off-price retailers are *factory outlets*, *independents*, and **warehouse clubs**.

...

The Future of Retailing

🔴 To be successful, retailers of the future will have to choose target segments carefully

and position themselves strongly. But the life cycle of retail forms is getting shorter:

- department stores took 100 years to reach the mature stage of the product life cycle;
- catalog showrooms and furniture **warehouse stores** reached maturity in about 10 years.
- Essentially, retailers can no longer sit back with a successful formula. To remain successful, they must keep adapting. ...³

The Trademark Examining Attorney also included several other Internet hits that use this same terminology in a consistent fashion:

HEADLINE: **Sears buys Orchard Supply** -
The next battle of "Hardware Wars" begins, as Sears moves to become your neighborhood hardware store!

...

The last major battle, which is still raging in communities across America, surrounds the Home Depot and its wannabees. Their **warehouse stores** have changed the way in which people shop for their home. **Warehouse retailing** has been responsible for driving nearly 1/3 of all hardware stores and home improvement centers out of business. ...⁴

ADVERTISEMENT HEADING: **Order Entry Software Systems**
-- **Product Distribution**

Retailing has undergone even more change. Intensive pre-selling by manufacturers and the development of minimum-service operations, for example, self-service in department stores, have drastically changed the retailer's way of doing business. Supermarkets and discount stores have become commonplace not only for groceries but for products as diversified as medicines and gardening equipment. More recently, **warehouse retailing** has become a major means

³ <http://tolearn.net/marketing/retailing.htm>

⁴ <http://www.colehardware.com/hotline/96/09/Sears.htm>

of retailing higher-priced consumer goods such as furniture, appliances, and electronic equipment. The emphasis is on generating store traffic, speeding up the transaction, and rapidly expanding the sales volume. Chain stores - groups of stores with one ownership - and cooperative groups have also proliferated. Special types of retailing, for example, vending machines and convenience stores, have also developed to fill multiple needs.⁵

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a Henry Stewart publication

Published Quarterly, the Journal [of Retail & Leisure Property] presents articles by leading thinkers in the field, working at some of the most respected companies and research institutions. Each issue of the journal contains around 100 pages and up to 10 industry articles, briefings and robust research pieces examining property types which include:

- Mixed use development
- ***Warehouse retailing***
- Department stores
- ...⁶

The Trademark Examining Attorney also supplied third-party trademark registrations wherein the term "Warehouse" is disclaimed on the Supplemental Register for retail store and mail order services.

Applicant argues that the Trademark Examining Attorney has failed to demonstrate that the term "warehouse" is

⁵ <http://www.order-entry-software-systems.com/product-distribution.html>

⁶ <http://www.henrystewart.com/journals/lp/mission.html>

generic for applicant's services. Applicant points to a dictionary definition of "warehouse" that places an emphasis on the building where goods are stored. Applicant argues that the third-party registrations are not probative of what the relevant consuming public understands the term to be, and that the services in the listed registrations are somewhat different when compared with the services herein. Applicant also argues that the abbreviated LEXIS/NEXIS excerpts are too brief to conclude that the term, as used in the articles, has a connotation different from the dictionary definition in the record. Finally, applicant contends that the college syllabus excerpt shows that the generic term for the type of services at issue herein is "warehouse retailing," not the word "warehouse" alone.

Based upon the NEXIS articles and Internet information made of record herein, we find that the Trademark Examining Attorney has made a substantial showing based on clear evidence that warehouse retailing is the generic designation of a genus of retailing. Taken together, we find that the term "warehouse retailing" is an established term of art. It involves the retailing of merchandise such as groceries, drugs, hardware, home improvement, home

furnishings, appliances, and electronic equipment, in a superstore type of warehouse atmosphere where a premium is placed on speeding up the transactions. The facilities are typically in warehouse-sized structures with a minimum of services offered, and the consumer performs the bulk of the functions in a self-service mode.

In fact, applicant appears to concede this possibility:

On page 3 of [the college syllabus], the generic name of the type of services here in issue clearly is identified as "warehouse retailing"; not the word "warehouse" alone....

Applicant's appeal brief, p. 10 [emphasis in original]. To the extent that applicant agrees with the Trademark Examining Attorney that "warehouse retailing" may indeed be a generic designation, it is curious then to argue that the term WAREHOUSE alone is a source indicator for such services.

Certainly, under the type of analysis in which the Court engaged in the [SCREENWIPE] case ..., the term "attic sprinkler" for sprinklers used in an attic would be generic. That is to say, the separate words "attic" and "sprinkler" joined to form a compound "attic sprinkler" have a meaning identical to the meaning common usage would ascribe to those words as a compound. The fact that applicant has chosen to not include the term "sprinkler" in the mark sought to be registered should not lead to the registrability of ATTIC standing alone.

The simple fact is that ATTIC, when applied to sprinklers for use in an attic, "immediately and unequivocally describes the purpose, function and nature of the goods." ... In reaching our decision, we readily acknowledge the sometimes-used distinction that generic names are nouns and descriptive terms are adjectives. [2 J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 12:10 \(4th ed. 1997\)](#) ["A rule of thumb sometimes forwarded as distinguishing a generic name from a descriptive term is that generic names are nouns and descriptive terms are adjectives. However, this 'part of speech' test does not accurately describe the case law results."]. Here, we recognize that applicant's mark does not present the classic case of a generic noun, but rather a generic adjective. In this case, because the term ATTIC directly names the most important or central aspect or purpose of applicant's goods, that is, that the sprinklers are used in attics, this term is generic and should be freely available for use by competitors.

In re Central Sprinkler Company, 49 USPQ2d 1194 (TTAB 1998). Similarly, the mere fact that applicant herein has chosen to not include the term "retailing" in the mark sought to be registered should not lead to the registrability of the word WAREHOUSE standing alone.

In the interest of completeness, we turn next to whether applicant has sustained its burden of proof with respect to establishing a *prima facie* case that the merely descriptive term WAREHOUSE has in fact acquired distinctiveness in connection with applicant's services. That is, as an alternative basis for her refusal to

register, the Trademark Examining Attorney has taken the position that even if this mark should be found not to be generic, applicant has failed to make out a *prima facie* case that the term WAREHOUSE has in fact acquired distinctiveness in connection with applicant's services.

By amending the application to set forth a claim of acquired distinctiveness, applicant has in effect conceded that the term WAREHOUSE is merely descriptive of its services. Such a claim is tantamount to an admission that the term WAREHOUSE is not inherently distinctive and therefore is unregistrable on the Principal Register, in light of the prohibition in Section 2(e)(1) against merely descriptive marks, absent a showing of acquired distinctiveness pursuant to Section 2(f). See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) ["Where, as here, an applicant seeks a registration based on acquired distinctiveness under Section 2(f), the statute accepts a lack of inherent distinctiveness as an established fact"].

Holding strongly to the position that this matter is highly descriptive if not generic, the Trademark Examining Attorney did not encourage applicant to seek registration under Section 2(f) of the Act. However, the Trademark Examining Attorney did explicitly reject as insufficient applicant's claim (dated June 2, 2001) of more than five

years of substantially exclusive and continuous use of the mark in commerce preceding the filing date of this application, and suggested as an alternative the possibility that applicant might submit evidence demonstrating the degree to which applicant and its predecessor in interest had promoted this matter as a source indicator:

The applicant's mark is highly descriptive as applied to the goods/services. Therefore, the applicant's allegation of five years use alone is insufficient evidence of distinctiveness. The applicant may submit actual evidence to prove the distinctiveness of the mark in commerce. The Office will decide each case on its own merits. The examining attorney will consider the following principal factors in this decision: (1) how long the applicant has used the mark; (2) the type and amount of advertising of the mark; and (3) the applicant's efforts to associate the mark with the goods/services. [citations omitted]. This evidence may include specific dollar sales under the mark, advertising figures, samples of advertising, consumer or dealer statements of recognition of the mark and any other evidence that establishes the distinctiveness of the mark as an indicator of source.

Office action of November 27, 2002, pp. 1 - 2. However, the record reflects no further attempt by applicant to provide this type of evidence.

Accordingly, we find in the alternative, that even if this term should be found not to be generic, it is so

highly descriptive that applicant's *de minimis* showing under Section 2(f) of the Act is completely inadequate.

Decision: The refusal to register under Section 2(e)(1) of the Act, based upon a finding of genericness, is hereby affirmed. Additionally, should this term be found not to be generic, it is nonetheless so highly descriptive, that applicant has failed to make a sufficient showing of acquired distinctiveness under Section 2(f) of the Act, and this refusal, in the alternative, is also affirmed.